

REMARKS

Claims 1-21 are pending in the application. Claims 3 and 15 have been amended.

In the Office Action, the specification was objected to because page 8, lines 7-8 of the specification states that a sensor metallization 309 is shown in Figs. 4(a)-(d), but no such reference numeral appears in Figs. 4(a)-4(d). This paragraph of the specification has been amended to properly reflect that sensor metallization 309 is shown in Figs. 3(a)-(b), not in Figs. 4(a)-4(d). Additionally, the second full paragraph on page 8 of the specification has been amended to include a reference to Figs. 4(a)-4(d). These amendments are supported by the drawings, and by the specification paragraphs before and after the amended paragraphs. Care has been taken to avoid the introduction of new matter. Applicants believe these amendments are fully responsive to the Examiner's concerns.

Claims 3 and 15 were objected to because of various informalities. Claims 3 and 15 have been amended as suggested by the Examiner to correct these errors. Applicants believe the amendments to claims 3 and 15 are fully responsive to the Examiner's concerns.

Claims 1 and 2 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 4 and 24 of copending U.S. Application No. 10/391,633, entitled "Detecting Field From Different Ignition Coils Using Adjustable Probe". Claims 1, 2, 13, 14, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,396,277 (Fong) in view of U.S. Patent No. 5,493,49 (James). These rejections are respectfully traversed. Applicants respectfully request reconsideration and allowance of the claims in view of the following arguments.

Regarding the double-patenting rejection of claims 1 and 2, a terminal disclaimer is being filed herewith to overcome this rejection.

Regarding the obviousness rejection of independent claims 1 and 14 based on Fong and James, it is admitted in the Office Action that the primary Fong reference does not disclose the recited sensor displacement assembly, but it is contended that James furnishes a teaching of this claim element, and that it would have been obvious to modify Fong's capacitive sensor to add James' sensor displacement assembly to yield the claimed invention.

Applicants disagree. James does not disclose or suggest the claimed sensor displacement assembly. Nowhere in the Office Action is it specified which part of James' device comprises the claimed sensor displacement assembly, or is analogous to it. It is well-established that, to make out a *prima facie* case of obviousness, the Examiner must show that all the claim elements are taught or suggested by the prior art. The Examiner has not met this burden in the present case. The Office Action merely points out that James' device can be moved once it is mounted on a coil pack, by sliding it laterally. However, it is not even alleged that James teaches or suggests a sensor displacement assembly having "at least one member configured to move at least a portion of the sensor metallization [relative to] an ignition coil housing, while the substrate is mounted on an ignition coil housing", as recited in claims 1 and 14. James does not teach or suggest a *member* configured to move the sensor metallization, as claimed. Rather, James teaches that the entire sensor assembly can be manually moved relative to the coil pack by a technician user. James does not teach or suggest any structure (*i.e.*, the claimed "member") for moving its sensor relative to a coil pack, as claimed. Thus, the combination of Fong and James cannot render claims 1 or 14 obvious, because any such combination, however made, would still be missing the recited sensor displacement assembly.

Even assuming, *arguendo*, that James discloses the recited sensor displacement assembly, it would not have been obvious to combine Fong and James as suggested by the

Examiner to yield the invention of claims 1 and 14. The Examiner has not provided the required objective teaching in the art that would have motivated a skilled artisan to combine the teachings of James and Fong to yield the invention of claims 1 and 14. Fong does not provide any such objective teaching, and the passage of James cited by the Examiner to support the obviousness rejection does not provide it either. The Examiner contends (e.g., at page 5 of the Office Action) that it would have been obvious to modify Fong with a mechanism to move its substrate relative to an ignition coil housing while the substrate is mounted to the housing “in order to have a reliable method/apparatus allowing for engine diagnostics”. The Examiner points to col. 2, lines 23-26 of James for support of this contention. However, this is not an accurate characterization of James’ disclosure, and does not support the obviousness rejection.

At col. 2:23-26, James states that an object of his invention “is to provide a reliable method for determining cylinder identification . . . thereby allowing for engine diagnostics.” This passage clearly evidences that James is concerned primarily with cylinder identification, rather than being generally concerned with engine diagnostics. This is confirmed by the remainder of James’ disclosure, which concerns attaching a probe to a coil pack of a wasted spark distributorless ignition system (see Figs. 1-3 of James). In contrast, Fong relates to a device that attaches to a COP ignition coil housing, rather than to an ignition coil pack for firing multiple spark plugs, as does James’ device. Fong does not relate in any way to cylinder identification. Therefore, one skilled in the art would not have been motivated by James to modify Fong’s device to yield the invention of present independent claims 1 or 14.

Consequently, independent claims 1 and 14 are patentable, as are claims 2, 13 and 16, which depend from claims 1 and 14, respectively.

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Reconsideration and withdrawal of the rejection of claims 1, 2, 13, 14 and 16 is respectfully requested.

Claims 3-12, 15 and 17-21 have been objected to in the Office Action as being dependent upon a rejected base claim. However, since their respective base claims 1 and 14 are patentable, these claims are also patentable.

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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